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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/602,212	06/23/2000	Ursula Buchholz	15280-398100US	9937

7590 10/06/2004  
JEFFREY J KING, ESQ.  
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EXAMINER

CHEN, STACY BROWN

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/602,212

### Applicant(s)

BUCHHOLZ ET AL.

### Examiner

Stacy B Chen

### Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-101 is/are pending in the application.
- 4a) Of the above claim(s) 48-56, 88 and 89 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47, 57-87 and 90-101 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Applicant's amendment filed August 16, 2004 is acknowledged and entered. Claims 1-101 are pending. Claims 1-47, 57-87 and 90-101 are under examination. Claims 48-56 and 88-89 are withdrawn from consideration, being drawn to non-elected inventions.

#### ***Terminal Disclaimer***

2. The terminal disclaimer filed on August 16, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,264,957 and 6,699,476 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Priority***

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120. Copendency between the current application and the prior application is required. Applicant's desire to claim the benefit of later-filed application, USSN 09/847,173, as a relational priority claim, is improper. Therefore, the prior art rejections of record are reinstated in view of the priority date granted to this instant application, which is the filing date of provisional application 60/143,132, filed July 9, 1999. The specification should be amended to reflect the correct claim to priority.

#### ***Claim Rejections - 35 USC § 102***

4. Claims 1-2, 6-8, 16, 46, 63-66, 73, 82 and 90 are rejected under 35 U.S.C. 102(a) as being anticipated by Buchholz *et al.* (*J. Virology*, 1999, 73:251-259), for reasons of record.

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Claims 1-29, 46-47, 57-82, 85-87, 90-92, 95, 98, and 99 are rejected under 35 U.S.C. 102(b) as being anticipated by Murphy *et al.* (WO 98/02530), for reasons of record. Claims 1-29, 46-47, 57-82, 85-87, 90-92, 98 and 99 are rejected under 35 U.S.C. 102(e) as being anticipated by Collins (6,364,957), for reasons of record. See the Office action of June 13, 2002 for details of the rejections.

### ***Double Patenting***

5. Provisional obviousness type double patenting rejections were previously made over co-pending applications 10/030,951 and 10/031,095, both of which have been abandoned.

Therefore, those provisional rejections are moot.

6. Claims 36-37 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 39-49 of co-pending application 09/611,829. The co-pending application is now US Patent 6,713,066. Therefore, the rejection is no longer provisional. Claims 36-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 39-49 of US Patent 6,713,066, for reasons of record.

7. (*New Rejection*) Claims 1-47, 57-87 and 90-101 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-47, 57-87 and 90-101 of copending Application No. 10/704,116. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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***Conclusion***


8. No claim is allowed.

This action is non-final because of the new provisional double patenting rejection.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stacy B. Chen whose telephone number is 571-272-0896. The examiner can normally be reached on M-F (7:00-4:30). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James C. Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

*SBC*  
Stacy B. Chen  
September 21, 2004

  
JAMES HOUSEL 10/1/04  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600